

REMARKS

In accordance with the above-amendment, reference to the earlier Great Britain priority documents has been deleted from the specification. Claims 1-3 and 5-23 remain under consideration; claim 24 has been deemed withdrawn from consideration as being directed to a non-elected invention.

With regard to matters of the specification, applicants believe that the sequence numbers (Sequence I.D. Nos. 1-6) are believed to be adequately identified on page 10 of the specification as referring respectively to the sequences 1-6 which follow and so should meet the requirements of Item 5 in the latest Official Action.

Applicants greatly acknowledge the withdrawal of the rejection of claims 1-23 under 35 USC § 112, however, they remain of the opinion that the claims are unobvious and should also be allowed on the merits. In this respect, entry and consideration of the following additional remarks are respectfully requested.

The rejection of claims 1-3 and 5-23 under 35 USC 103(a) as being unpatentable over Donnelly et al. EP 0 532 090 A2 (issued Sept. 2, 1992), in view of Fawell et al. (PNAS 91: 1994), Murphy US 5,668,255 (issued Sept. 16, 1997, priority to June 27, 1991). Zimmerman et al. US 5,652,341 (issued July 29, 1997, priority to Dec. 4, 1992), Lowenadler et al. (Mol. Immunology 29:1195, 1992), Noguchi et al. (PNAS 3171, April 1994) and Roemer et al. PNAS(90:9252, 1993) as repeated by the Examiner is respectfully traversed.

In this regard, it is noted that the Examiner has picked certain elements from each of the references in an effort to piece together polypeptides which may have some properties in common with the claimed properties without either considering the references as a whole or considering whether the references taken as a whole would lead one to make the suggested combination. For example, the combination generally suggested by the Examiner could be applied to literally thousands of variations of polypeptides which may clearly have diverse uses not relevant to those claimed. Moreover, it is not believed that the Examiner has shown sufficient evidence that the references, when taken as a whole, themselves contain the motivation which would lead to the suggested combination. Not only must the art suggest combination, but it must also suggest the manner of combining the references relied on by the Examiner.

In this regard, the presence of any clear reason for adding the contribution of each of the references to the whole, based on the references themselves and not the applicants' specification is clearly relevant and clearly something that one skilled in the art would have had to be led to do. It is believed that absent applicants' specification explaining the applicability of the particular combination and the reason for the present combination, the suggested combination would not have occurred to one of ordinary skill.

It is well known that without such independent suggestion, the Examiner has impermissibly used "hindsight" occasioned by the

applicants' teachings to hunt through the prior art for the claimed elements and combined these as claimed. In this regard, applicants believe that the present rejection exceeds the bounds of permissible retrospective inquiry sanctioned by the present state of the law. See In re. Zurko 111 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997); In re. Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); In re. Bond, 910 F.2d 831, 15 USPQ2d 1556 (Fed. Cir. 1990), such is considered merely to be inviting unguided and speculative experimentation which is not the standard with which obviousness is to be determined. See also Sensonics, Inc. v. Aerisonic Corp., 81 F.3d 1566, 157, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996) and In re. Dembicza, 50 USPQ2d 1614 (Fed. Cir. 1999).

It remains the applicants' position that the combination of references suggested by the Examiner amounts in total to selective substitutions and those substitutions suggested by the Examiner would not be made considering the references as a whole absent the teachings of applicants' specification and therefore must be considered to be the result of hindsight.

It is believed that the rejection of claims 1-3 and 5-23 under 35 USC § 103(a) should be reconsidered and these claims allowed in view of the additional remarks contained in this paper. This being the case, the Examiner is respectfully requested to enter this Amendment, reconsider and allow the present claims.

The Examiner is requested to address replies to the undersigned attorney (who is of record) & firm listed below as the successor in interest of HAUGEN AND NIKOLAI.

Respectfully submitted,

NIKOLAI, MERSEREAU & DIETZ., P.A.



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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment in response to the Office Action of April 13, 1999, a Petition for a one-month Extension of Time in application Serial No. 08/737,457, filed on November 13, 1996 of Donald L.N. Cardy et al., entitled "IMPROVEMENTS IN OR RELATING TO PEPTIDE DELIVERY", and a transmittal letter are being sent by facsimile transmission to: The Commissioner of Patents and Trademarks, Washington, D.C. 20231, on August 12, 1999.



Barbara L. Davis
Secretary to C. G. Mersereau

Date of Signature: August 12, 1999